



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*ml*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,281	08/06/99	SILVERBROOK	K 169.0013-DI

005514 LM02/0316  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

EXAMINER

NGUYEN, P

ART UNIT	PAPER NUMBER
----------	--------------

2772

*4*

DATE MAILED:

03/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/369,281

Applicant(s)

SILVERBROOK

Examiner

Phu K. Nguyen

Group Art Unit

2772



☒ Responsive to communication(s) filed on Aug 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 84-93 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 84-93 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2772

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 85-93 are rejected under the judicially created doctrine of double patenting over claims 81-84 of U. S. Patent No. 6,020,894 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the compressed image data are stored in the bands which are processed to manipulate the image.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Art Unit: 2772

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84-93 are rejected under 35 USC 103 (a) as being unpatentable over Bantz et al. (US 4,679,038).

As per claim 1, Band teaches the "method of creating an image" comprising the step of multiple passing the bands to manipulate the image (Bantz, figure 1). It is noted that Bantz does not explicitly teach that the data stored in the bands are "compressed" as claimed. However, Bantz' bitmap memory 102 which stores the image bands suggests any step to efficiently store the image in the bitmap memory can be used such as compression for efficiently utilizing the memory space. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to configure Bantz' method as claimed by compressing the stored data before load them into the memory to save the memory.

Claim 85 adds into claim 84 the step of compressing and editing the stored image which are well known in a computer graphic system such as Bantz.

Due to the similarity of claims 86-93 to claims 84-85 they are rejected under a similar reason.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

Art Unit: 2772

***Conclusion***

3. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry), Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phu K. Nguyen, whose telephone number is (703)-305-9796 and can normally be reached Monday-Friday from 6:30 AM to 3 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

Phu K. Nguyen

Patent Examiner

Art Unit 2772

  
PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400